REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 5, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1, 5-13, 17-23, and 29-31 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Epstein (U.S. Pat. No. 6,601,172). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Epstein reference. Applicant discusses the Epstein reference and Applicant's claims in the following.

A. The Epstein Disclosure

Epstein discloses transmitting revisions with digital signatures. Epstein, Patent Title. Included in Epstein's disclosure is electronic notarizing. The notarizing process is described in relation to Figures 1a-1d. As is described by Epstein, an author creates a report on a workstation. Epstein, column 2, lines 33-37. The author's workstation hashes the

report and encrypts the hash using the author's private key to form a signature for the report. Epstein, column 2, lines 40-48. The workstation then transmits the report and the signature to a customer's server. Epstein, column 2, lines 55-57. The server hashes the report and decrypts the author's signature using the author's public key. Epstein, column 2, lines 60-62.

The server then sends *the author's signature* to a notary's host system. Epstein, column 3, lines 6-9. The notary host system receives the author's signature, creates a time stamp containing the author's signature, receipt time, notary id, sequence number, and customer id. Epstein, column 3, lines 15-17. The notary host system hashes the time stamp and signs it using the notary's private key, and then returns to the server the time stamp and the notary's signature. Epstein, column 3, lines 17-22. The server stores the time stamp and the notary's signature "*with relation to* the report." Epstein, column 3, lines 28-32 (emphasis added).

As can be appreciated from the above, Epstein's notary host system does not retrieve image data to be notarized. Moreover, Epstein's notary host system does not notarize such image data. Instead, Epstein's notary host system notarizes *an author's signature* that is sent to the notary host system from a customer server that received imaging data (a "report") from an author's workstation.

B. Applicant's Claims

Epstein fails to teach several of Applicant's claim limitations. Applicant discusses some of those claim limitations in the following.

1. Claims 1, 5-12, and 29-31

Applicant's claim 1 provides as follows (emphasis added):

> 1. A method for notarizing imaging data, comprising:
>
> ***retrieving imaging data on behalf of a user*** via a network ***from the user's personal imaging repository*** with a network-based notarization service ***via an imaging extension***; and
>
> ***electronically notarizing the imaging data*** with the network-based notarization service.

(a) Applicant's Limitations

Epstein fails to teach multiple limitations of claim 1. First, Epstein does not teach "retrieving imaging data on behalf of a user". As is noted above, an author's workstation *transmits* a report and a signature to a customer's server. Later, the server then *sends* the author's signature to a notary's host system. Therefore, no component in Epstein's system "retrieves" imaging data on behalf of a user for the purpose of notarizing. Instead, imaging data (i.e., the report) is sent to a server and a signature is sent from the server to a notary host system.

Second, Epstein does not teach that such retrieval is from a user's "personal imaging repository". As is stated above, Epstein does not teach "retrieving" imaging data at all. Moreover, Epstein is silent as to the concept of a "personal imaging repository". Again, a

proper rejection under 35 U.S.C. § 102 requires that a reference teach *each and every limitation* of a rejected claim.

Third, Epstein does not teach that retrieval of imaging data from the user's personal imaging repository is accomplished with an "imaging extension". Once again, Epstein does not even contemplate retrieval of imaging data or a personal imaging repository. Furthermore, Epstein says absolutely nothing about an "imaging extension". As is described in Applicant's specification, an "imaging extension" is a component that is called upon to act as a gateway to access the user's personal imaging repository. Applicant's specification, page 9, line 11 to page 10, line 24. The term should be interpreted consistent with that definition. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part").

Fourth, Epstein does not teach "electronically notarizing the imaging data". As is described above, Epstein does not teach notarizing the author's report. Instead, as is described above, a customer server that receives the author's report and the author's signature *sends only the author's signature to a notary's host system*. As a result, the notary host system does not notarize the author's report at all. Instead, the notary host system returns only a time stamp and the notary's signature to the server, which then stores the time stamp and the notary's signature "*with relation to* the report." Epstein, column 3, lines 28-32 (emphasis added).

For at least the foregoing reasons, Epstein does not anticipate Applicant's claim 1 or its dependents.

(b) Response to Examiner's Arguments

Applicant further notes that the above-discussed limitations are not taught in the portions of the Epstein disclosure that are identified by the Examiner. For example, column 4, lines 19-22 provides as follows:

> In a first group of steps 160 in FIG. 2a, the author creates an image and transfers the image to a server which signs the image for the author and stores the image.
> [Epstein, column 4, lines 19-22]

First, the above expert explicitly states that the author "transfers" the image to the server. It is not stated that the server retrieves the image on the author's behalf. Second, the action of the server *signing* the image does not equate to *notarizing* the image. We know this because, later in column 4 with further reference to the method of Figure 2a, Epstein states that the server "establishes a connection with the notary's host, and in step 173, the server sends the server's image signature to the host". Epstein, column 4, lines 43-45. Therefore, the server's signing the image is step performed *prior to* notarization that, incidentally, is performed on the *server's signature* and not the image itself.

Regarding column 5, lines 15-47, also identified by the Examiner, that portion of the Epstein disclosure provides as follows:

> In the final set of steps 210 in FIG. 2d, a user requests the image for viewing on a viewer and the stored image is provided along with the two time stamps and the two notary's signatures s that the viewer can verify the origin and certification date of the original image and the origin and certification date of the revision and that according to the server the revision

is a product of the original image. In step 212, the user requests the image using the viewer. The viewer may be any equipment that allows the image to be played to the user. The viewer is not restricted to visual display and may be, for example, a loud speaker playing an audio image. In step 213, the server sends the image hash, the imager id, the image condensation, both related time stamps (one for the image and one for the compressed image) and similarly both notary's signatures to the viewer. In step 214, the viewer hashes the condensation time stamp and decrypts the notary's signature for the condensation using the notary's public key in order to verify the digital time and other information in the condensation time stamp. In step 215, the viewer hashes the image time stamp and decrypts the notary's image signature using the notary's public key to verify the image time stamp. In step 216, the viewer hashes the condensation, and in step 217, the viewer combines the condensation hash and the notary's image signature and decrypts the servers's condensation signature to verify the condensation time stamp including the condensation time. In step 218, the viewer combines the image hash and the imager id and decrypts the server's image signature to verify the imager id and imaging time. In step 219, the viewer compares the image time stamp time and the condensation time stamp time to verify that the times are very close. In step 220, viewer displays the image, imager id, imaging time and condensing time to the user.

[Epstein, column 5, lines 15-47]

Clearly, the above excerpt does not disclose retrieving imaging data on behalf of a user via a network from the user's personal imaging repository "with a network-based notarization service via an imaging extension". Although the excerpt can be interpreted as generally retrieving image data for the user to view, no "personal imaging repository" is mentioned and the retrieval is not performed by a "network-based notarization service".

Instead, it is the user that is retrieving his data. Applicant acknowledges that it is known for a user to retrieve his data to view it.

As a further point, the above excerpt fails to disclose "electronically notarizing the imaging data with the network-based notarization service". Simply stated, not such notarizing is described in the excerpt.

2. Claims 13 and 17-20

Applicant's claim 13 provides as follows (emphasis added):

> 13. A network-based notarization system for notarizing imaging data, comprising:
>
> ***means for retrieving imaging data*** on behalf of a user via a network ***from the user's personal imaging repository via an imaging extension***; and
>
> ***means for electronically notarizing the imaging data.***

Regarding claim 13, Epstein fails to teach "means for retrieving imaging data . . . via a network from the user's personal imaging repository via an imaging extension" or "means for electronically notarizing the imaging data", at least for reasons discussed in relation to claim 1. For those reasons, Applicant submits that claims 13 and 17-20 are allowable over Epstein.

3. Claims 21-23

Applicant's claim 21 provides as follows (emphasis added):

> 21. A network-based notarization service stored on computer-readable media, comprising:
>
> ***logic configured to retrieve a document*** on behalf of a user ***via an imaging extension***, the document being stored in a ***personal imaging repository*** of the user; and
>
> ***logic configured to electronically notarize the document.***

Regarding claim 21, Epstein fails to teach "logic configured to retrieve a document . . . via an imaging extension, the document being stored in a personal imaging repository of the user" or "logic configured to electronically notarize the document", at least for reasons discussed in relation to claim 1. For those reasons, Applicant submits that claims 21-23 are allowable over Epstein.

C. Conclusion

Due to the shortcomings of the Epstein reference described in the foregoing, Applicant respectfully asserts that Epstein does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 24 and 25

Claims 24 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epstein as applied to claims 1 and 5, in view of Schrieber, et al. ("Schreiber," U.S. Pat. No. 6,298,446). Applicant respectfully traverses this rejection.

As is identified above, Epstein does not teach several aspects of Applicant's claims. In that Schreiber does not remedy the deficiencies of the Epstein reference, Applicant respectfully submits that claims 24 and 25 are allowable over the Epstein/Schreiber combination for at least the same reasons that claim 1 is allowable over Epstein.

B. Rejection of Claims 26 and 27

Claims 26 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epstein as applied to claim 6, in view of Braam, et al. ("Braam," U.S. Pat. No. 6,957,347). Applicant respectfully traverses this rejection.

As is identified above, Epstein does not teach several aspects of Applicant's claims. In that Braam does not remedy the deficiencies of the Epstein reference, Applicant respectfully submits that claims 26 and 27 are allowable over the Epstein/Braam combination for at least the same reasons that claim 1 is allowable over Epstein.

C. Rejection of Claim 28

Claim 28 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epstein as applied to claim 7, in view of Natarajan (U.S. Pat. No. 6,611,599). Applicant respectfully traverses this rejection.

As is identified above, Epstein does not teach several aspects of Applicant's claims. In that Braam does not remedy the deficiencies of the Epstein reference, Applicant respectfully submits that claim 28 is allowable over the Epstein/Natarajan combination for at least the same reasons that claim 1 is allowable over Epstein.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

David R. Risley
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

1-19-06

Mary Meeper
Signature